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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,077	11/22/1999	DANA C. BOOKBINDER	16-6-1	3342

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CORNING INCORPORATED  
SP-TI-3-1  
CORNING, NY 14831

EXAMINER

MARKHAM, WESLEY D

ART UNIT PAPER NUMBER

1762

DATE MAILED: 01/30/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-15

**Advisory Action**

Application No.

09/447,077

Applicant(s)

BOOKBINDER ET AL.

Examiner

Wesley D Markham

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-33 and 50-58.

Claim(s) withdrawn from consideration: 34-49.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see attached Office Action

WDM

*WDM*

**DETAILED ACTION / ADVISORY ACTION**

***Drawings***

1. Acknowledgement is made of the formal drawings (2 figures, 2 sheets) submitted by the applicant with paper #13 on 12/2/2002 (with a certificate of mailing dated 11/26/2002). These formal drawings are approved by the examiner.

***Response to Amendment***

2. Acknowledgement is made of applicant's proposed amendment B, filed as paper #14 on 12/2/2002 (with a certificate of mailing dated 11/26/2002), in which the applicant proposed to amend independent Claim 1 and cancel Claims 3, 5 – 9, 13, 15, 22 – 26, and 31 without prejudice or disclaimer. However, this amendment has not been entered because it is not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the applicant proposed, in part, to cancel Claims 9 and 26. As Claims 10 – 12 (currently pending) depend from Claim 9 and Claims 27 – 29 (currently pending) depend from Claim 26, entry of the applicant's proposed amendment would raise new issues that compound, not simplify, the issues for appeal (i.e., the 35 U.S.C. 112 issues raised by having Claims 10 – 12 and 27 – 29 depend from canceled claims). Therefore, the applicant's proposed amendment has not been entered.

***Response to Arguments***

3. Applicant's arguments filed on 12/2/2002 have been fully considered but they are not persuasive.
4. As a preliminary matter, please note that the applicant's arguments regarding the claim objections and the 35 U.S.C. 112, first paragraph, rejection, are moot because the arguments are drawn to changes proposed in the applicant's amendment that has not been entered for the reasons set forth above in paragraph 2.
5. Regarding the 35 U.S.C. 103(a) rejection of Claims 50 and 53 over the combination of Tsuji et al. and Brack, the applicant argues that, since Brack is directed to release coatings while Tsuji is directed to a coating that is peeled-off of a glass preform, Brack is non-analogous art. In response, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Brack can be reasonably construed to be both in the field of the applicant's endeavor (i.e., the field of applying silane-containing or wax-containing temporary protective coatings – Col.1, lines 26 – 28, and Col.5, lines 21 – 30) and reasonably pertinent to the particular problem with which the applicant was concerned (i.e., the problem of handling articles during processing – Col.1, lines 29 – 30).
6. Second, the applicant argues that applying the teachings of Brack to Tsuji would destroy the operability of the Tsuji invention, in that the coating of Tsuji must be

peelable. In response, it is simply supposition on the part of the applicant that applying the teachings of Brack would destroy the operability of the Tsuji invention. In other words, this conclusion is not supported by any evidence. Importantly, please note that the examiner has not argued that it would have been obvious to one of ordinary skill in the art to utilize the specific coatings of Brack as the peelable coating of Tsuji. On the contrary, the examiner has argued that it would have been obvious to add a lipophilic silane and/or wax (as taught by Brack) as an additive to the peelable coating of Tsuji. Since this additive has good slip and release properties (Col.1, lines 62 – 65), one of ordinary skill in the art would have reasonably expected that adding the silane and/or wax additive of Brack to the coating of Tsuji would advantageously allow the coating to be more easily peelable (i.e., leave no residual residue on the preform, as desired by Tsuji). Additionally, please note that Brack teaches yet another advantage of adding the oily or waxy material to a coating composition, specifically that the vapor barrier (e.g., oxygen, water) properties of the coating are improved (Col.2, lines 25 – 27).

7. Third, the applicant argues that Tsuji does not teach the use of a polyvinyl alcohol coating, and there is no suggestion in Woodhall to use a coating on an optical fiber article. In response to applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Briefly, please note that it is the objective of Tsuji to coat a silica-

containing (i.e., glass) article used in the manufacture of an optical fiber with a removable / peelable resin layer such as a polyvinyl system to prevent dust and dirt from contaminating the silica-containing article (i.e., preform). Woodhall teaches that it was known in the art of removable protective coatings at the time of the applicant's invention to coat a glass article with polyvinyl alcohol (i.e., a water soluble polymer) to temporarily protect the article during subsequent processing operations, and then to remove the material (i.e., the polyvinyl alcohol) from the article with a water wash or by peeling, or by a combination of the two (Abstract, Col.1, lines 28 and 32 – 35, and Col.2, lines 28 – 33). It would have been obvious to one of ordinary skill in the art to utilize the temporary protection process / polyvinyl alcohol composition of Woodhall to protect the glass article of Tsuji with the reasonable expectation of (1) success, as Woodhall teaches that the process is suitable for temporarily protecting glass articles, and (2) obtaining the benefits of utilizing the process of Woodhall, such as providing a protective film that adheres well to the surface to be protected, with few or no pinholes, and providing a film that can be easily removed with a water wash (Col.2, lines 28 – 33). Please note that Woodhall also teaches the functional equivalence of removing temporary protective films by washing and by peeling (i.e., the removal method taught by Tsuji). Although Tsuji does teach a peelable protective film, this is not the crux of the invention of Tsuji. The crux of the invention of Tsuji lies in providing a protective coating for a silica-containing article used in the manufacture of an optical fiber that can be removed at an appropriate point in the manufacturing process. As such, one of ordinary skill in the art would have at the

very least recognized substituting the temporary protective film / removal method (i.e., washing) of Woodhall for the temporary protective film / removal method (i.e., peeling) of Tsuji as a substitution of equivalents that would have led to similar results (i.e., successfully protecting a silica-containing article used in the manufacture of an optical fiber with a removable coating, as desired by Tsuji). In addition, a pinhole-free coating such as the one taught by Woodhall would have clearly been desirable in the process of Tsuji so as to provide complete protection of the silica-containing article.

8. In response to the applicant's argument that Woodhall teaches removing the coating after processing, not during further processing, please note that the examiner has not relied upon Woodhall to teach this limitation. However, please also note that, since the step of removing the coating is in and of itself a further processing step, the coating of Woodhall is "removed during further processing".
9. In response to the applicant's argument that it would only have been "obvious to try" the method taught in Woodhall on the silica-containing article of Tsuji, the examiner has clearly set forth the reasons for combining the teachings of Tsuji with Woodhall (see paragraph 7 above). Please note that the test of obviousness is not an express suggestion of the claimed invention in any or all references, but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them (*In re Rosselet*, 146 USPQ 183).

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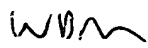
**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham  
Examiner  
Art Unit 1762

  
WDM  
January 28, 2003

  
SHRIVE P. BECK  
SUPERVISOR/TENT EXAMINER  
TECHNICAL CENTER 1700